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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,307	06/23/2000	Allen B. Childress	5053-27600	1776

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/603,307

Applicant(s)

CHILDRRESS ET AL.

Examiner

Vanel Frenel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed <sup>response</sup> amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
JOSEPH THOMAS  
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TECHNOLOGY CENTER 3600

*ADVISORY ACTION*

Note: Applicant's arguments and response filed 11/18/04 have been considered but do not overcome the rejection for at least the followings reasons:

(A) At pages 2-12 of the 11/18/04 response, Applicant argues :

- 1) The claims are not obvious over Borghesi in view of Abbruzzese pursuant to 35 U.S.C 103 (a).
- 2) Borghesi and Abbruzzese do not teach automatically determining a table of contents.
- 3) Abbruzzese does not teach an ordered list of steps associated with processing an insurance claim.
- 4) Abbruzzese does not teach automatically adding or deleted processing steps or modifying a sequence of processing steps in a table of contents.

(1) Applicant's request for consideration does not place the application in condition for allowance because : Applicant argues features that have not been entered as of the present communication, and Applicant's remarks fail to consider the full teachings of the applied references in the manner discussed in the prior Office Action.

With respect to Applicant's first argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472,

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223 USPQ 785, 788 (Fed. Cir.1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, Ex parte Levengood, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the

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Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the *Borghesi* and *Abbruzzese* references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the *Borghesi* reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered;

and

- (iii) the question is not express teaching of references, but what they would suggest.

(2) With respect to Applicant's second argument, Examiner respectfully relied on Borghesi for such a teaching and noted Borghesi discloses "a generic claim processing workflow is illustrated. The claim workflow shown in Fig.1 is tailored specifically for automobile insurance claims. Other types of insurance such as property or health insurance may also be mapped into the claim workflow shown in Fig.1 which correspond to Applicant's claimed feature (See Borghesi, Col.4, lines 64-67 to Col.5, line 1). Furthermore, Borghesi states "The workfile preferably comprises a plurality of individual sections represented by tabs 102 that designate the contents of that section" (See Borghesi, Fig.6; Col.8, lines 65-67 to Col.9, line 2). Therefore, Borghesi and Abbruzzese disclose the claimed feature and Applicant's argument is not persuasive.

(3) With respect to Applicant's third argument, Examiner respectfully submits that Abbruzzese suggests "a list of screens specific to the automobile line of insurance business in their logical order of appearance (screens marked with asterisks will potentially become new claims): Policy information screen (required); Special procedures (optional unless extracted from Policy Index Table) etc. which also be interpreted as content of properties (See Abbruzzese, Col.19, lines 18-67). The list of screens correspond to an ordered set of processing steps that are displayed based on received input. Some of the screens are required and some are optional. The listing of displayed screens

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depend on the received input information. Therefore, Abbruzzese and Borghesi teach the claimed feature and Applicant argument is not persuasive.

(4) With respect to Applicant's fourth argument, Examiner respectfully submits that Abbruzzese suggests "a list of screens specific to the automobile line of insurance business in their logical order of appearance (screens marked with asterisks will potentially become new claims): Policy information screen (required); Special procedures (optional unless extracted from Policy Index Table) etc. which also be interpreted as content of properties (See Abbruzzese, Col.19, lines 18-67). The list of screens correspond to an ordered set of processing steps that are displayed based on received input. Some of the screens are required and some are optional. The listing of displayed screens depend on the received input information. Therefore, Abbruzzese discloses deleting or adding one or more steps from the table of contents in response to the received input from an insurance claim processing step and Examiner notes that Abbruzzese discloses (See Table XXVI) a directory table which contains a listing of codes which correspond to several names (See Abbruzzese, Col.39, line 47). The directory table represents a type of table of contents in that unique directory codes are listed along with their contents. The contents for each of the directory codes are processed by the claim processing steps. Therefore, the claim processing steps are associated with Table of Contents properties and Applicant's argument is not persuasive. As such, it is respectfully submitted that the Final Rejection mailed 09/15/04 is indeed proper, and hereby maintained.

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Others arguments presented appear to rehash issues addressed in the Final

Rejection of the 09/15/04. .